

REMARKS

Claims 1 and 3-14 are pending in the present application.

I. Claim Rejections

The Examiner has rejected claims 1 and 3-14 as being unpatentable under 35 USC § 103(a) over Landis (5,692,514) in view of Yarush (4,850,023). The cited art does not contain a teaching or suggestion to combine, nor are all limitations taught; therefore, reconsideration of the rejections and allowance is respectfully requested.

Regarding all pending claims, Applicant notes that Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

M.P.E.P. § 2143. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." M.P.E.P. § 2142.

Rather than provide an objective motivation or suggestion to combine the references, Examiner only provides a conclusory statement:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the apparatus of Landis with the apparatus of Yarush to provide a lower cost listening device capable of connecting to a plurality of audio probes which are capable of detecting and transferring sounds from a variety of mechanical devices, while providing a balanced aural sensation to the user.

(Office Action at 3.) Applicant notices that the statement is merely a concatenation of objects listed in the Yarush patent. Indeed, Yarush discloses the connection of a plurality of discrete audio probes to a single microphone, but nowhere is there any disclosure that such an arrangement would be or could be carried on a hat. Since there exists no suggestion, teaching or motivation to combine the references, aside from Applicant's disclosure, Examiner has not met the burden of establishing a *prima facie* case of obviousness; therefore, reconsideration and allowance is respectfully requested.

In addition to failing to establish a motivation to combine, Examiner admits that not all of the claim limitations are taught, especially regarding claims 10 and 14. Applicant acknowledges Examiner's admission that "Yarush fails to teach a second microphone." (8/21/06 Office Action, page 3.) In fact, neither of the references relied upon by Examiner teaches a second microphone. Examiner relies on *St. Regis Paper Co. v. Bemis Co.*, 193 U.S.P.Q. 8 (7th Cir. 1977), for the proposition that "mere duplication of the essential working parts of a device involves only routine skill in the art." (Office Action, page 4.) However, *St. Regis* involved the duplication of layers of material to increase the strength of a bag. *St. Regis Paper* at 11. Therefore, the additional component served no other function than to duplicate function already provided, albeit by way of making the bag stronger. However, where duplication of parts produces a different result, patentable significance is achieved. See M.P.E.P. § 2144.04(VI)(B) (citing *In re Harza*, 124 U.S.P.Q. 378, 380 (CCPA 1960)).

This case is significantly different than that in *St. Regis* and, instead, involves a separate component that provides, as required by *Harza*, a new result. Significantly, regarding claims 1 and 8, the second microphone coupled to the second speaker and second earpiece achieves a different result from the first microphone. That is, the first microphone provides aural tones to a first ear. The second microphone does not perform the same function as the first. The second microphone does not provide aural tones to the first ear. Rather, the second microphone provides aural tones to a second ear of a user. The second microphone does not merely perform the same function as the first; therefore, the second microphone is not merely duplicative.

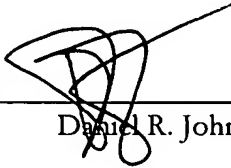
Furthermore, regarding claim 11, Examiner has cited no art having a tee-fitting coupled to three lengths of tubing. As is commonly understood in the art, a tee is "something shaped like a T, as a three-way pipe joint." *Random House Webster's College Dictionary* 1341 (2d ed. 1999) (see attached exhibit). Therefore, a tee-fitting generally is recognized as having three ports; one input and two outputs, or two inputs and one output. Examiner cited to Yarush reference numerals 22(a) and 22(b) as a tee-fitting. Respectfully, Applicant submits that 22(a) and 22(b) are not tee-fittings but are rather shouldered couplers having only an input and an output. Therefore, since neither Yarush nor Landis disclose multiple lengths of tubing coupled together by a tee-fitting, Applicant requests that the rejection be withdrawn and the claim passed to allowance.

Based on the lack of motivation to combine and Examiner's admission that the second microphone is not taught in the cited art, reconsideration of the rejections and allowance is respectfully requested.

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Respectfully Submitted,

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